



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,134	09/19/2003	Kan Fujihara	89227.0005	7184
26021	7590	10/20/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			TRAN, THAO T	
		ART UNIT	PAPER NUMBER	
		1711		
DATE MAILED: 10/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/667,134	FUJIHARA ET AL.
	Examiner Thao T. Tran	Art Unit 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 August 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/6/05.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendments filed 8/5/2005. The Affidavit filed 8/5/2005 and the IDS filed 6/6/2005 are also acknowledged.
2. Claims 1-25 are currently pending in this application. Claims 1-12, 15, 18-19, and 25 have been amended.

Claim Rejections - 35 USC § 112

3. In view of the prior Office action of 3/2/2005, the rejection of claims 2-7, 10-25, under 35 U.S.C. 112, second paragraph, has been withdrawn due to the Amendments made thereto.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 7-14, 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Akahori et al. (US Pat. 5,081,229).

Akahori teaches a laminate comprising a metal layer and a polyimide film. The polyimide film is prepared by copolymerization an acid dianhydride component and a diamine component; wherein the acid dianhydride component includes a pyromellitic dianhydride and a biphenyl

tetracarboxylic dianhydride; and the diamine component includes a paraphenylene diamine and a diaminodiphenyl ether. The acid dianhydride component includes 50% or more of pyromellitic dianhydride and the diamine component includes 20-80% of paraphenylene diamine and/or diaminodiphenyl ether or the molar ratio of diaminodiphenyl ether to paraphenylene diamine is $\frac{1}{4}$ - 4 (see abstract; col. 2, ln. 19-63; col. 4, ln. 65-68; col. 5, ln. 1-66; col. 6, ln. 1-29).

Although Akahori is silent with respect to the specific properties of the polyimide film, such as dynamic elastoviscosity and water absorption, since the reference teaches the same chemical components in the polyimide film, the film would inherently have the same properties as presently claimed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-7, 15-16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akohori as applied to claims 1-4, 7-14, 17-24 above, and further in view of Tanaka (JP 2000-297163).

Akohori is as set forth in claims 1-4, 7-14, 17-24 above and incorporated herein.

Akohori does not teach the addition of bis(trimellitic monoester anhydride).

Tanaka teaches the addition of phenylenebis(trimellitic monoester anhydride) in the formation of the polyimide film (see abstract). Therefore, it would have been obvious to one of

ordinary skill in the art, at the time the invention was made, to have employed bis(trimellitic monoester anhydride, as taught by Tanaka, in the formation of the polyimide film of Akohori, for the purpose of improving the storage modulus, average linear thermal expansion coefficient, tensile modulus, and elongation strength.

Response to Arguments

8. Applicant's arguments filed 8/5/2005 have been fully considered but they are not persuasive.

Throughout the Remarks, Applicants contend that Akahori differs from the presently claimed invention because the polyimide film in the Akahori reference does not have the tan δ peak temperature and value as presently claimed. To support this argument, Applicants have provided an Affidavit including comparative examples to elucidate how the presently claimed invention would be novel and nonobvious over the prior art. However, the Affidavit provides the use of samples from a selective group of polyimide precursors as indicated on page 600 thereof. These are specific polyimide precursors and are not commensurate with the scope of the claims.

Applicants are reminded that since the reference or combination of the references discloses the laminate having the same chemical compositions in different layers, the film or laminate would inherently have the same chemical and physical properties.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt

October 17, 2005

Thao Tran

THAO T. TRAN
PATENT EXAMINER